

REMARKS

I. STATUS OF CLAIMS

Claims 121, 132, 137, 143-144, 147, 153, 157-158, 161, 166, 169-170, 172, 177-180, 183, 218-219, 221, and 223 are pending in this application. Claims 122, 124, 127, 129, and 131 have been cancelled without prejudice or disclaimer. Claims 121, 132, 161, 218, 219, 221 and 223 have been amended.

Applicants specifically note that support for amended claims 121, 161, 218, 219, 221 and 223, which recite “at least one structuring polymer chosen from ethylenediamine/stearyl dimer dilinoleate copolymer and ethylenediamine/stearyl dimer tallate copolymer,” can be found in the originally filed specification at least on page 15 at lines 3-13. This paragraph recites Uniclear® polyamide polymers and that these polymers are “mixtures of copolymers derived from monomers of (i) C₃₆ diacids and (ii) ethylenediamine” and “[t]erminal ester groups result from esterification of the remaining acid end groups with at least one alcohol chosen from cetyl alcohol and stearyl alcohol.” *Id.* This description readily conveys an ethylenediamine/stearyl dimer dilinoleate copolymer or an ethylenediamine/stearyl dimer tallate copolymer to one of ordinary skill in the art. See *also* International Cosmetic Ingredient Dictionary and Handbook (“CTFA”), page 606, 9th ed. (2002) (attached as Exhibit 1) (stating that ethylenediamine/stearyl dimer dilinoleate copolymer is a copolymer of ethylenediamine and stearyl dimer dilinoleate monomers, and further reciting that a trade name for this copolymer is known in the art to be Uniclear®, and also stating that ethylenediamine/stearyl dimer tallate copolymer is a copolymer of ethylenediamine and tall oil dimer acid monomers, end-blocked with stearyl alcohol, and further reciting that a

trade name for this copolymer is known in the art to be Uniclear®). Moreover, claim 132 has been amended in view of the amendment to claim 121, on which it depends. Thus, the amendments to claims 121, 132, 161, 218, 219, 221 and 223 are fully supported by the specification as filed. Accordingly, no new matter is introduced by the amendments.

II. REJECTIONS UNDER 35 U.S.C. § 103

A. Rejection under 35 U.S.C. § 103 over U.S. Patent No. 5,783,657 to Pavlin et al., U.S. Patent No. 6,682,749 to Potechin et al., and U.S. Patent No. 6,214,329 to Brieva et al.

The Examiner rejects claims 121-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 169-170, 172, 177-180, 183, 218-219, 221, and 223 under 35 U.S.C. § 103(a) over the combination of U.S. Patent No. 5,783,657 to Pavlin et al. ("Pavlin"), U.S. Patent No. 6,682,749 to Potechin et al. ("Potechin"), and U.S. Patent No. 6,214,329 to Brieva et al. ("Brieva"). See Office Action at 3-4. The Examiner asserts that Pavlin teaches the claimed polymers of formula (I), that Potechin teaches the claimed pasty fatty substance (identified as a thickener by the Examiner at page 4 of the Office Action), and that Brieva teaches specific volatile oils, specific fillers, pigments, coloring agents, etc. *Id.* at 3-4. The Examiner concludes that "it would have been obvious to one of ordinary skill in the cosmetic art at the time the invention was made to prepare compositions using the polymer of [Pavlin] and add the pasty fatty substance [of Potechin] which has been used in compositions that function as gel . . . and use the specific volatile solvents and waxes of [Brieva] . . . expecting that the compositions are useful as (cosmetics)." *Id.* at 4. According to the Examiner, "[t]he motivation to combine the ingredients [of the three references] flows logically from the art for having been used in the same cosmetic art." *Id.* Applicants respectfully traverse the rejection

to the extent it applies to the presently amended claims for at least the following reasons.

In making a rejection under 35 U.S.C. § 103, the Examiner “bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. § 2142. In its decision in *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the “framework for applying the statutory language of §103” was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art; and
- (4) secondary considerations.

383 U.S. at 17, 148 U.S.P.Q. at 467. However, the Court indicated that there is no necessary inconsistency between the idea underlying the teaching, suggestion, or motivation (“TSM”) test and the *Graham* analysis. *KSR*, 127 S. Ct. at 1741, 82 U.S.P.Q. 2d at 1389. As long as the TSM test is not applied as a “rigid and mandatory” formula, the test can provide “helpful insight” to an obviousness inquiry. *Id.*

In the present case, the cited prior art does not teach or suggest all the elements of the present claims. Applicants have amended claims 121, 161, 218, 219, 221 and 223 to recite specific structuring polymers chosen from ethylenediamine/stearyl dimer dilinoleate copolymer and ethylenediamine/stearyl dimer tallate copolymer. While

Pavlin teaches a composition comprising a compound of formula (I), as the Examiner points out, nothing in Pavlin would direct one of skill in the art to the specific species of structuring polymers now recited in claims 121, 161, 218, 219, 221 and 223 (ethylenediamine/stearyl dimer tallate and dilinoleate copolymers). Notably, a generic formula does not, by itself, necessarily render a compound encompassed by that formula obvious. *In re Baird*, 16 F.3d 380, 382, 29 U.S.P.Q.2d 1550, 1551 (Fed. Cir. 1994). Potechin and Brieva do not cure the deficiencies in Pavlin as neither reference teaches these specific polymers. As such, the cited art does not teach the claimed polymers, and the Examiner cannot support a *prima facie* case of obviousness based on these references. See M.P.E.P. § 2144.08; *In re Ruschig*, 343 F.2d 965, 974, 145 U.S.P.Q. 274, 282 (CCPA 1965) (Rejection of claimed compound in light of prior art genus based on *Petering* is not appropriate where the prior art does not disclose a small recognizable class of compounds with common properties.).

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

B. Rejection under 35 U.S.C. § 103(a) over U.S. Patent Nos. 6,402,408 to Ferrari et al., 6,960,339 to Ferrari, and 7,144,582 to Ferrari et al., all taken individually and combined with Potechin and Brieva

The Examiner rejects claims 121-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 169-170, 172, 177-180, 183, 218-219, 221, and 223 under 35 U.S.C. § 103(a) over U.S. Patent Nos. 6,402,408 to Ferrari et al. ("Ferrari '408"), 6,960,339 to Ferrari ("Ferrari '339"), and 7,144,582 to Ferrari et al. ("Ferrari '582"), all taken individually and combined with Potechin and Brieva. See Office Action at 5. The Examiner alleges that the three references to Ferrari or Ferrari et al. (collectively "the

Ferrari references”) constitute prior art under 35 U.S.C. § 102(e), based upon their effective U.S. filing dates. *Id.* The Examiner identifies the effective filing date of the instant application as December 28, 2000, because “there is no certified translation of the foreign priority document,” according to the Examiner. *Id.*

Applicants submit that these three Ferrari references are not legally valid prior art against the present application under 35 U.S.C. § 103(a). Ferrari ‘408 was filed on July 17, 2000, and issued on June 11, 2002. Ferrari ‘339 was filed on July 17, 2000, and issued on November 1, 2005. Ferrari ‘582 is a continuation-in-part of U.S. Application No. 09/618,066, which was filed on July 17, 2000, and Ferrari ‘582 issued on December 5, 2006. The present application was filed on December 28, 2000. Accordingly, as the Examiner points out, Ferrari ‘408, Ferrari ‘339, and Ferrari ‘582 only constitute prior art under 35 U.S.C. § 102(e) against the claims of the present application.

As amended by the American Inventors Protection Act of 1999 (“AIPA”), § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more subsections of (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. (emphasis added).

Further, M.P.E.P. § 706.02(I)(1) states:

Enacted on November 29, 1999, the American Inventors Protection Act (AIPA) added subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) as disqualified as prior art against the claimed invention if that subject matter and the claimed invention ‘were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same

person.' The 1999 change applied to all utility, design and plant patent applications filed on or after November 29, 1999. (Emphasis added) (citations omitted).

Ferrari '408, Ferrari '339, Ferrari '582, and the instant application were subject to an obligation of assignment to L'Oréal S.A. at the time the presently claimed invention was made, as evidenced by the assignment information recorded for Ferrari '408 on September 12, 2000, at Reel 011057, Frame 0007; the assignment information recorded for Ferrari '339 on September 11, 2000, at Reel 011057, Frame 0676; the assignment information recorded for Ferrari '582 on January 22, 2001, at Reel 11455, Frame 0203; and the assignment information recorded for the instant application on April 20, 2001 at Reel 011723, Frame 0518. Accordingly, Ferrari '408, Ferrari '339, Ferrari '582 and the instant application were, at the time the invention was made, commonly owned, and thus, the Ferrari references are not legally valid prior art against the present application under 35 U.S.C. § 103(a).

Absent the Ferrari references, none of the remaining cited references teach or suggest the structuring polymers of the present claims. In the absence of such a teaching, the Examiner cannot support a *prima facie* case of obviousness.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

C. Provisional Rejections under 35 U.S.C. § 103(a) over U.S. Patent Application Publication Nos. 2002/0114773, 2002/0122781, 2002/0120036, 2002/0107314, and 2002/0111330

The Examiner provisionally rejects claims 121-122, 124, 127, 129, 131-132, 137, 143-144, 147¹, 153, 157-158, 161, 166, 169-170, 172, 177-180, 183, 218-219, 221, and 223 under 35 U.S.C. § 103(a) over U.S. Patent Application Publication Nos. 2002/0114773 ("U.S. '773"), 2002/0122781 ("U.S. '781"), 2002/0110036² ("U.S. '036"), 2002/0107314 ("U.S. '314"), and 2002/0111330 ("U.S. '330"), all taken individually and combined with Potechin and Brieva. The Examiner cites the various U.S. patent application publications for their alleged teachings of claimed polymers of formula (I), Potechin for its alleged teaching of the claimed pasty fatty substance, and Brieva for its alleged teachings of specific elements in the dependent claims. See Office Action at 5. Again, the Examiner asserts that the motivation to combine the ingredients from these references "flows logically from the art for having been used in the same cosmetic art." *Id.* at 7.

Initially, Applicants point out that the Examiner incorrectly refers to this rejection as provisional. Only subject matter that is prior art under 35 U.S.C. § 102 can be used to support a rejection under 35 U.S.C. § 103. See M.P.E.P. § 2141.01. In a provisional rejection, the publications would not qualify as prior art against the present application.

¹ Applicants note that the Examiner did not list claim 147 among the rejected claims but assume such omission was a typographical error. If Applicants understanding is incorrect, Applicants request clarification.

² The Examiner confirmed in a telephone conference with Applicants' representative that this Patent Application Publication number contains a typographical error and the correct publication number is 2002/0120036.

Thus, issuing a provisional § 103 rejection is improper under U.S. Patent Office practice.

Regardless, Applicants submit that the instant applications are not legally valid prior art against the present application, and therefore, the rejection is improper. Specifically, U.S. '773 was filed on December 12, 2000, and published on August 22, 2002; U.S. '781 was filed on December 12, 2000, and published on September 5, 2002; U.S. '036 was filed on December 12, 2000 and published on August 29, 2002; U.S. '314 was filed on December 12, 2000, and published on August 8, 2002; and U.S. '330 was filed on December 12, 2000, and published on August 15, 2002. Thus, these five publications only qualify as prior art under § 102(e) against the present application.

U.S. '773, U.S. '781, U.S. '036, U.S. '314, and U.S. '330 and the instant application were subject to an obligation of assignment to L'Oréal S.A. at the time the presently claimed invention was made, as evidenced by the assignment information recorded for U.S. '773 on April 20, 2001, at Reel 011723, Frame 0503; the assignment information recorded for U.S. '781 on April 20, 2001, at Reel 011639, Frame 0897; the assignment information recorded for U.S. '036 on April 26, 2001, at Reel 011765, Frame 0183; the assignment information recorded for U.S. '314 on April 2, 2001, at Reel 011654, Frame 0869; the assignment information recorded for U.S. '330 on April 4, 2001, at Reel 011646, Frame 0966; and the assignment information recorded for the instant application on April 20, 2001, at Reel 011723, Frame 0518. Accordingly, these five publications and the instant application were, at the time the invention was made,

commonly owned, and thus, are not legally valid prior art against the present application under 35 U.S.C. § 103(a) for the same reason as discussed in Section II.B. above.

Absent the five cited publications, none of the remaining cited references teach or suggest the structuring polymers of the present claims. In the absence of such a teaching, the Examiner cannot support a *prima facie* case of obviousness.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

III. CO-PENDING APPLICATIONS

In previous submissions, Applicants noted information regarding co-pending applications and patents, including the present application, and submitted copies of the pending claims as of the date of those submissions for every case identified. Applicants submit herewith, as Exhibit 2, a copy of the pending and/or issued claims of Application Nos. 09/685,578, 09/733,900, 09/733,899, 10/466,168, 10/450,108, 10/012,052, 11/826,997, 09/733,897, 10/918,579, 09/733,896, 10/203,254, 10/699,780, 10/747,412, and 10/494,864, which have been amended or issued since June 6, 2007. Applicants submit those claims for the Office's convenience in evaluating any potential issues regarding statutory or obviousness-type double patenting.

IV. INFORMATION DISCLOSURE STATEMENT

At page 2 of the Office Action, in a section entitled "Information Disclosure Statement," the Examiner states that "foreign patents that are not in English language have been considered to the extent that [they] read on the abstracts or English language equivalents."

With regard to the Examiner's statements and representations, Applicants note that translations of foreign references are not required, and "[s]ubmission of an English language abstract of a reference may fulfill the requirement for a concise explanation." M.P.E.P. § 609.04(a).III. The Examiner has not cited any authority to the contrary. Notably, the Examiner initialed all the foreign language patents on the IDS form PTO/SB/08 considered on August 18, 2007, and returned with the August 24, 2007, Office Action. As such, Applicants believe they have complied with the Office's requirements for listing foreign references.

V. CONCLUSION

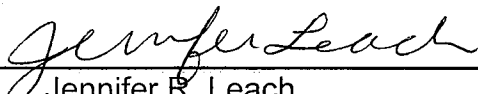
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: February 14, 2008

By: 
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Attachments:

Exhibit 1: International Cosmetic Ingredient Dictionary and Handbook
("CTFA"), page 606, 9th ed. (2002).

Exhibit 2: 14 Sets of Claims from Co-Pending Applications